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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

2/1219US

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on 28 December 2006

Application Number

10/769,973

Filed

02 Feb 2004

First Named Inventor

Wootton, et al.

Signature Electronically filed

Art Unit

1742

Examiner

Minh Chau Thi Pham

Typed or printed name _____

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

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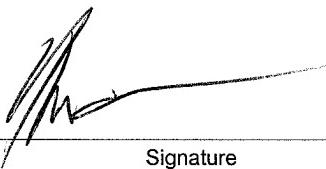
applicant/inventor.

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.

Registration number 42,461



Signature

Kirk A. Damman

Typed or printed name

314-444-7783

Telephone number

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

December 28, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
Wootton et al. :
:
Appln. No. 10/769,973 : Art Unit: 1724
:
Filed: 2 February 2004 : Examiner: Minh Chau Thi Pham
:
For: NBC FILTRATION UNIT PROVIDING : Docket No.: 2/1219US
UNFILTERED AND FILTERED PATHS :

Commissioner for Patents
Alexandria, VA 22313

Arguments for Pre-Appeal Brief Request for Review

Sir:

As part of the request for pre-appeal brief review, Applicant submits the following arguments in conjunction with the enclosed Pre-appeal Brief Request for Review form and Notice of Appeal. This filing is timely, as the August 31, 2006 Office Action constituted a final rejection of Applicant's claims, placing the application in position for appeal. Applicant has studied the Office Action mailed August 31, 2006 and has the following arguments, which are submitted to advise the pre-appeal panel of the fact that no appeal before the Board is necessary.

In these arguments, Applicant respectfully identifies a clearly improper final rejection based upon a clear legal deficiency. Applicant respectfully contends that the Examiner misapplied the law by not giving patentable weight to the inclusion of the Nuclear Biological and Chemical (NBC) filter (or filtration) and Environmental Control Unit (ECU) in the language of the pending claims leading to the current rejection of the claims under 35 USC §§102 and 103.

In the Second Office Action in the present case (October 5, 2005) and in response to Applicants' assertion that the cited references of the first Action failed to show inclusion of a

Nuclear, Biological, and Chemical (NBC) filter in the filtered path as indicated by the claims, the Examiner stated that “[t]he phrase ‘a nuclear biological and chemical (NBC) filtration unit for use with a portable environmental control unit (ECU)’ has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause,” and that “it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.” [Page 3]

After Applicants responded that the inclusion of an NBC filter was an element of all independent claims and entitled to weight, the Examiner responded in a March 3, 2006 Office Action [Page 3] that the argument of Applicants was unpersuasive repeating the above.

In an attempt to make clear the inclusion of the elements of the NBC filter and ECU were structural elements of the claim, Applicants then amended claim 1 and added new independent claims 21 and 23 in their June 29, 2006 response to clarify that both the NBC filter and ECU were structural limitations, in addition to their appearance in the preamble. The Examiner, however, again responded in the August 31, 2006 Office Action [Page 3] that the NBC and ECU elements were not given patentable weight reciting the same reasoning as above.

Applicant respectfully contends that the rejections are clearly erroneous, because regardless of whether the elements of an NBC filter and Environmental Control Unit (ECU) appear in the preamble, they are entitled to patentable weight as structural limitations of the claim and are not simply a recitation of use. Applicants note that MPEP 2111.02 discusses the weight of a preamble while MPEP 2111.04 and 2114 discuss the effect of functional language in

apparatus claims.

Independent Claim 1 of the instant application specifically recites: “A . . .filtration unit . . .comprising: . . .a second air flow path allowing air flow from said environment through an NBC filter in said filtration unit and to said ECU. . . .” [emphasis added]

Independent Claim 21 of the instant application specifically recites: “A . . .filtration unit . . . comprising: a first air flow path allowing air flow from an external environment, through a first NBC filter in said filtration unit and to an ECU” [emphasis added]

MPEP 2111.02 and 2111.04 agree that whether a claim phrase is a limitation is determined on a claim by claim basis, and MPEP 2111 and 2114 agree that phrases which serve as limitations to the structure of a claimed invention must be treated as claim limitations. The above phrases clearly limit the structure as they recite a filtration unit having an air flow path, the air flow path allowing air flow through an NBC filter in the filtration unit. There is clearly a structural limitation that the claimed filtration unit include an NBC filter, as otherwise the filtration unit claimed could not provide a path allowing air to flow from the environment, through an NBC filter in the filtration unit, and into an ECU. As the presence of an NBC filter in the filtration unit is therefore clearly a structural limitation of the filtration unit, it is entitled to patentable weight and the Examiner’s failure to grant it patentable weight is clear error.

Applicants also note that the air flow path allowing air flow into an ECU would also comprise a structural limitation on the filtration unit. The situation is similar to that recited in In re Stencel, 828 F.2d 751, 4 USPQ2d 1071 (Fed Cir. 1987) as discussed in MPEP 2111.02. In In re Stencel, it was found that while the structure of a collar did not directly limit a claim to a driver, the driver’s structure was limited by its use with the collar, rendering it appropriate to consider such structural limitation of the driver when comparing to the prior art. The structure of

the filtration unit of the present claims is similarly limited by the filtration unit having an air flow path which allows air to flow into an ECU. Again, as the presence of an ECU is clearly a structural limitation on the air flow path of the filtration unit, it is entitled to patentable weight and the Examiner's failure to grant it patentable weight is clear error.

Applicants believe that, while it is not expressly stated in the August 31, 2006 Office Action, the Examiner also failed to grant the "wherein" clause of claim 1 related to the arrangement of valves for purging of the air flow path patentable weight as allegedly being directed to operation. Like the above, this wherein clause is also entitled to patentable weight as it necessarily limits the structure of the valves as they need to be able to be arranged to provide the "purge" path described by the wherein clause of claim 1. Applicants specifically pointed out such path could not be generated on the device of Grandjean et al. in their June 29, 2006 response and again, the Examiner's failure to give this limitation patentable weight is clear error.

With regards to claim 23, claim 23 is presented with all elements in means plus function form (35 USC 112 6th paragraph). It is well established that a functional statement when used in such form is necessary for understanding the claim and should be given weight as the function of the means is necessary for its interpretation.

Claim 23 specifically recites: "A filtration unit comprising: means to force air through a first air flow path said first air flow path providing nuclear, biological and chemical (NBC) filtered air to said shelter . . ." As this clearly recites that the filtration unit comprises means to force the air through a path which provides NBC filtration, part of the function is clearly related to the NBC filtration of the air, and again failure to consider the limitation is clear error.

Should the elements of the NBC filter and the ECU be given their appropriate patentable weight, the application is believed fully allowable. Applicants have repeatedly pointed out that

the cited references do not show these elements and the inclusion of the elements is not obvious from the cited references.

Conclusion

In light of the above remarks, Applicant believes there are no further issues regarding the patentability of the pending claims and respectfully request the Panel recognize this clear legal deficiency and find the second rejection erroneous, eliminating the need for appeal. Applicant further respectfully requests the Panel find the application allowable on the existing claims so that this case can pass on to issue, or, in the alternative, to reopen prosecution.

Applicant submits the fee necessary for the accompanying Notice of Appeal and a one month extension of time. In addition, the Commissioner is authorized to credit any overpayment or charge any deficiencies necessary for entering this amendment, including any claims fees and/or extension fees to/from our **Deposit Account No. 50-0975**.

If any questions remain, Applicant respectfully requests a telephone call to the below-signed attorney at (314) 444-7783.

Respectfully submitted,
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